

Application No.: 10/537,332

Docket No.: 209546-98124

REMARKS

Claims 1-9 are currently pending. No claims have been rejected and no claims have been allowed. In this paper, Applicant has added claims 10-12. No new matter has been added. Upon entry of this paper, claims 1-12 will be pending. Applicant respectfully requests examination of the present application in view of the foregoing clarifying amendments and the following remarks.

I. Election

Applicant hereby provisionally elects

- "Invention A" (i.e., claims 1-2), and
- "Species B" (i.e., Figure 2)

as identified by the Examiner on pages 2-3 of the Office Action. The above election by the Applicant is made *with traverse* for the foregoing reasons. See M.P.E.P. §818.03, 8th Ed., 6th Rev. (September, 2007).

**818.03 Express Election and Traverse
[R-3]*****37 CFR 1.143. Reconsideration of requirement.***

If the applicant disagrees with the requirement for restriction, he may request reconsideration and withdrawal or modification of the requirement, giving the reasons therefor. (See § 1.111). In requesting reconsideration the applicant must indicate a provisional election of one invention for prosecution, which invention shall be the one elected in the event the requirement becomes final. The requirement for restriction will be reconsidered on such a request. If the requirement is repeated and made final, the examiner will at the same time act on the claims to the invention elected.

Applicant respectfully points out that independent claims 1 and 3 both include *the same claim constituents* (i.e., a core, a binding agent, a first layer of chopped fiberglass, a scrim, a catalyst, and a coverstock) that collectively define a rigid headliner assembly. The only difference between independent claims 1 and 3 is that claim 1 is an *apparatus* claim and that claim 3 is a *method / process* claim for making the apparatus recited in claim 1.

Further, Applicant respectfully points out that the Examiner has erred by indicating that there are five species (i.e., Species A, B, C, D and E), which are alleged to be defined, respectively, by Figures 1-5. Referring below to Figure 1, it can be seen that "Species A" (i.e.,

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the laminated headliner assembly 10) is also found in Figures 2 and 5, which is allegedly "Species B" and "Species E."

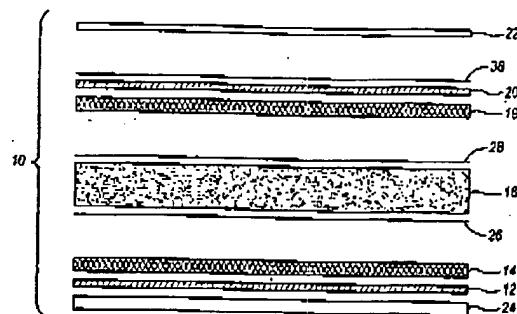


FIG. 1

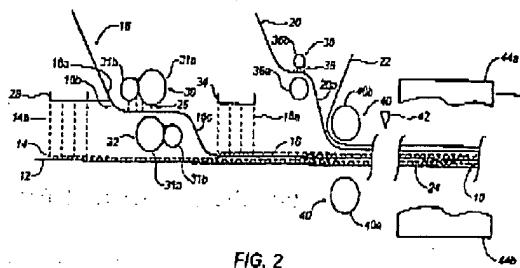


FIG. 2

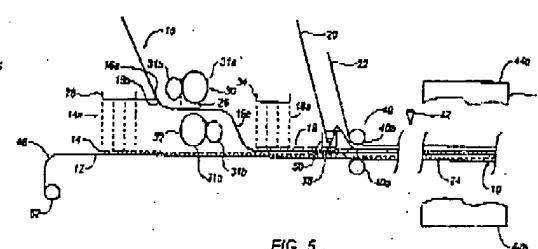


FIG. 5

In view of this, Applicant respectfully asks how can there be five species in the present application when, in fact, the laminated headliner assembly 10 is included in each of the distinct, alleged "species" in at least Figures 2 and 5?

In view of the above, Applicant respectfully submits that the Examiner has erred by identifying three separate inventions (i.e., Inventions A, B and C) and five species (i.e., Species A, B, C, D and E). Arguably, the similarity of the claimed constituents in independent claims 1 and 3 would collectively identify one invention at claims 1-5, and, due to the fact that the laminated headliner assembly 10 is shown in each of Figures 1, 2 and 5, a single species should be found in at least Figures 1, 2 and 5.

In view of the above remarks, Applicant therefore requests the above restriction be reconsidered by the Examiner. See M.P.E.P. §818.03, 8th Ed., 6th Rev. (September, 2007). Claims 1-5 should be treated as a single invention with Figures 1, 2 and 5 being treated as a single species. Withdrawal of the restriction and examination of claims 1-5 in view of Figures 1, 2 and 5 is hereby requested.

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II. New Claims

Applicant has added claims 10-12 in this paper. Claims 10-12 are dependent claims that depend from elected independent claim 1 that reads on "Invention A" and "Species B." Applicant acknowledges the requirements of M.P.E.P. §821.03, 8th Ed., 6th Rev. (September, 2007), as noted below:

**821.03 Claims for Different Invention
Added After an Office Action
[R-3]**

Claims added by amendment following action by the examiner, MPEP § 813.01, § 813.02(a), to an invention other than previously claimed, should be treated as indicated by 37 CFR 1.145.

37 CFR 1.145. Subsequent presentation of claims for different invention.

If, after an office action on an application, the applicant presents claims directed to an invention distinct from and independent of the invention previously claimed, the applicant will be required to restrict the claims to the invention previously claimed if the amendment is elected, subject to reconsideration and review as provided in §§ 1.143 and 1.144.

The action should include form paragraph 8.04.

8.04 Election by Original Presentation

Newly submitted claim [1] directed to an invention that is independent or distinct from the invention originally claimed for the following reasons: [2]

Since applicant has received an action on the merits for the originally presented invention, this invention has been constructively elected by original presentation for prosecution on the merits. Accordingly, claim [3] withdrawn from consideration as being directed to a non-elected invention. See 37 CFR 1.142(b) and MPEP § 821.03

**>A< complete action on all claims to the elected invention should be given.
**

Regarding the requirements of 37 CFR §§ 1.143 and 1.144, as cited above in M.P.E.P. §821.03, 8th Ed., 6th Rev. (September, 2007), Applicant notes that a potential provisional withdrawing of claims 10-12 by the Examiner may be traversed by the Applicant. Should the provisional withdrawing of the claims be made final by the Examiner, Applicant acknowledges his right to petition the Director to review the requirement.

In view of the requirements of 37 CFR §§ 1.143 and 1.144, Applicant requests that the Examiner considering the following:

- Claim 1 is an independent apparatus/product claim;
- Claims 10-12 are means-plus-function/process claims that are in *dependent* form, depending directly or indirectly from claim 1; and

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- Claims 10-12 are added at an early stage of prosecution, responsive to the 1/8/08 restriction requirement.

In view of the above and referring to M.P.E.P. §821.04(b), 8th Ed., 6th Rev. (September, 2007), Applicant respectfully points to the following:

to 37 CFR 1.121. In view of the rejoinder procedure, and in order to expedite prosecution, applicants are encouraged to present such process claims, preferably as dependent claims in the application at an early stage of prosecution. Process claims which depend from or otherwise require all the limitations of the patentable product will be entered as a matter of right if the amendment is presented prior to final rejection or allowance, whichever is earlier. However, if appli-

(emphasis added).

Based on M.P.E.P. §§821.03, 821.04 and 821.04(b), 8th Ed., 6th Rev. (September, 2007), dependent claims 10-12 should be entered as a matter of right as they were added at an early stage of prosecution and prior to a potential Final Office Action. Accordingly, it can be understood that the above requirements are in place to expedite prosecution of the application and to limit the withdrawing of related, dependent claims that may be examined due to the fact that the dependent claims may ultimately be rejoined, examined and allowed.

Thus, it is respectfully submitted that Applicant has properly presented claims 10-12 for examination and that any potential provisional withdrawing of claims 10-12 would be improper according to at least M.P.E.P. §821.04(b), 8th Ed., 6th Rev. (September, 2007). Full consideration and examination of the limitations of claims 10-12 on the merits is hereby requested.

Conclusion

Applicant believes no fee is due with this response. However, if a fee is due, please charge our Deposit Account No. 50-3145, under Order No. 209546-98124 from which the undersigned is authorized to draw.

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Dated:

OAKLAND.1414610.1

Respectfully submitted,

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